

REMARKS/ARGUMENTS

Claims 1 and 2 are pending in this application and both have been rejected. Several informalities within the claims have been pointed out by the Examiner and corrected by the Applicant. Claim 2 has been rejected under 35 U.S.C. 102(b) as being anticipated by Fell, Sr. Additionally, claims 1 and 2 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo et al. in view of Lewis. Applicant respectfully traverses all rejections.

The Examiner has rejected claim 2 under 35 U.S.C. 102(b) as being anticipated by Fell, Sr. (U.S. Patent No. 5,115,554). Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289

F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 2 has been amended to require "an overflow pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises an internally threaded portion ... and a solid cap threadably mounted in the first end". In contrast, Fell discloses a plug 43 that is threadably mounted in the cylindrical body 17 of a closet flange 16 and not an overflow pipe as is required by claim 2. Therefore, each and every limitation of the claim is not met and the anticipation rejection must be withdrawn.

Claims 1 and 2 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo et al. in view of Lewis. There is no suggestion or motivation to combine the prior art to make out a *prima facie* case of obviousness. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill

in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although

the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

All the obvious rejections asserted by the Examiner are based on a combination of prior art references, e.g. the conventional overflow assembly of Oropallo, combined with the threading on the capture nut of Lewis. To justify this combination the Examiner stated "[i]t would have been obvious to one of ordinary skill in the bathtub overflow system art, at the time the invention was made, to provide the horizontal leg of the overflow drain pipe of Oropallo et al. with internal threads which engage external threads on the cap in view of the teaching of Lewis in order to create an effective water-tight seal without the need for installation of a decorative overflow plate." (Examiner's Answer, page 3).

While the Examiner has suggested that the nature of the problem is creating an effective water tight seal, the Examiner has not identified within the references a suggestion or motivation to adapt the expandable plug 8 and capture nut 21 of Lewis with the cap 40 of Oropallo.

To create a water tight seal, Lewis discloses a capture nut 21 that is screwed down upon threaded member 23 using threads 22 to match therewith. Alternatively, the threaded

member 23 could be formed with interior threads, and the capture nut 21 with outer threads. [0020] ... In completing the assembly, test plug 8 is then screwed down upon elbow 20 (by the rotation of wing nut 7) as shown and described in reference to Figs. 3A and 3B. [0021] Thus, while Lewis suggests the interchangeability of the threads on a capture nut, it does not suggest the replacement of the test plug 8 held in place with wing nut 7 with a solid cap as claimed by the Applicant.

Oropallo discloses a pressure test cap 40 thread connected at 41 to the tubular terminal 13a. (Col. 3, lines 34-35). This particular construction allows for quick removal of decorative cap 10 and quick installation of pressure test cap 40, for a testing of the plumbing for leaks. Oropallo does not suggest any other means of providing a water tight seal and certainly not adapting the test plug, wing nut, and capture nut of Lewis to arrive at the Applicant's claimed invention.

Accordingly, because the Examiner has not particularly identified any suggestion or motivation to combine the prior art references, the Examiner's conclusion of obviousness as a matter of law, cannot stand.

In addition, the combination of the prior art references does not lead to the invention as claimed. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All

words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 in part requires "a solid cap threaded into interior threads of the horizontal leg extending through the overflow port to close the end of the horizontal leg." Similarly, claim 2 requires "a solid cap threadably mounted in the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded into the first end." In order to present all of the limitations of the claimed invention, the Examiner has taken the overflow pipe 11 of Oropallo and modified it to have internal threads based on Lewis which teaches one to reverse the threads on the threaded member 23. The Examiner also takes the cap 40 of Oropallo and modifies it to have external threads based on Lewis which teaches one to reverse the threads on capture nut 21.

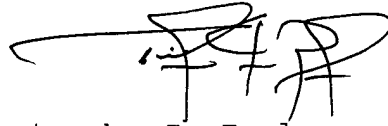
The combination, however, does not meet the limitations of claims 1 and 2. Specifically, even if there were a suggestion to place internal threads within the overflow pipe 11 of Oropallo and external threads on cap 40, because the diameter of cap 40 is greater than the diameter of the overflow pipe 11, the cap 40 could not be threaded into the interior threads of the overflow pipe as is required by claims 1 and 2. The only way to arrive at a cap that will thread into the overflow pipe is to use Applicant's disclosure as a blue print.

Consequently, the claimed combination does not meet each and every limitation of claims 1 and 2 and therefore, the obviousness rejection must be withdrawn.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Zarley', with a long horizontal stroke extending to the left.

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